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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,688	03/01/2004	Jeffrey Bergh	HARD1.072A	2600
60148 7590 01/23/2007 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			EXAMINER KENNEDY, JOSHUA T	
			ART UNIT 3679	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/23/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/791,688

Applicant(s)

BERGH ET AL.

Examiner

Joshua T. Kennedy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-15, 19, 25-27, 29-37, 39-45 and 68-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, 19, 25-27, 29-37, 39-45 and 68-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1-7, 9-15, 19, 25-27, 29-37, 39-45, and 68-78 have been examined.

Claims 8, 16-18, 20-24, 28, 38, and 46-67 have been cancelled.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-15, 19, 25-27, 29-37, 39-45, and 68-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caceres et al in view of Gleeson et al (US Patent Application Publication 2001/0047741).

As to Claims 1-4, 9-12, 15, 25, 26, 31, 34-36, 42, 68, 70, and 72. Caceres et al disclose a fence system, comprising:

a horizontal mounting surface (15); and

a plurality of individual elongate members or pickets (13) attached to the horizontal mounting surface, wherein each individual member has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the plurality of individual members are made into a desired shape for use in the fence system prior to curing (Col 3, Lines 29-35) and

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wherein the front surface and back surface of the individual members are embossed with a pattern thereon resembling a wooden picket (Col 3, Lines 29-36)

a plurality of individual fasteners (Col 2, Lines 19-22) for attaching the plurality of individual members (13) to the horizontal mounting surface (15), wherein each individual fastener passes through the front surface and the back surface of the individual member into the horizontal mounting surface, and

said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1).

Caceres et al do not disclose the plurality of individual members made of a plurality of layers of fiber cement whereby the plurality of individual members do not exhibit any substantial visible separation or fraying of the fibers along surfaces of the plurality of individual members after curing, wherein the fiber cement forming the plurality of individual members incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the plurality of individual members as taught by Caceres to be constructed of the fiber cement building material as taught by Gleeson et

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al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

It is also noted that the limitation of "the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed when the features are present. See MPEP § 2113.

As to Claims 5, 19, 69, and 75. Caceres et al disclose the upper end of the plurality of individual members being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1— Shows the pickets with a dog-eared shape).

As to Claims 6, 7, 18, 27, 29, 30, 32 and 76-78. Caceres et al disclose the front surface and back surface of at least one individual member having a first surface, wherein the

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first surface has a finish that is has a pattern resembling wood and the color thereof or masonry (Col 3, Lines 29-36).

As to Claims 13, 14, 43, and 44. Caceres et al disclose the horizontal mounting surface comprising a pair of mounting rails (15) having a longitudinal axis, and the at least one individual member is positioned in a manner such that a longitudinal axis of the individual members (or pickets) is substantially perpendicular to the longitudinal axis of the horizontal mounting surface, wherein a first mounting rail is secured to the pickets at an upper location of the pickets, and a second mounting rail is secured to the pickets along a lower location of the pickets (Fig 1).

As to Claim 33. Caceres et al disclose the picket capable of being nailed onto a fence rail (Col 2, Lines 19-22).

As to Claims 34 and 37. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has an aspect ratio of between 4 and 12 and is spaced from one another by a distance of between about 1/2 and 1 inch. However, it is stated that "the slats may be spaced such that there is visibility between each slat (Col 2, Lines 5-7) and it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have an

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aspect ratio of between 4 and 12 and be spaced from one another by a distance of between about 1/2 and 1 inch so as to achieve the desired aesthetic appearance.

As to Claims 39, 71, and 73. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a length between about 6 and 8 feet. However it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have an a length between about 6 and 8 feet so as to achieve the desired functionality and aesthetic appearance.

As to Claims 40 and 74. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a width between about 4 and 12 inches. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a width between about 4 and 12 inches so as to achieve the desired aesthetic appearance.

As to Claim 41. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a thickness of between about 5/16 and 3/4 inch. However, it is not inventive to state the optimum or workable values of the size of the pickets. As

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determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a thickness of between about 5/16 and 3/4 inch so as to achieve the desired aesthetic appearance.

As to Claim 45. Caceres et al disclose at least two posts (17), each of said posts having an elongate configuration extending between an upper end and a lower end and being substantially parallel to the pickets, said posts being secured to the mounting rails, wherein the lower ends of the posts extend below the lower ends of the pickets to secure the posts in a ground location (Fig 1).

Claims 25-27, 29-33, and 68-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newberry, Jr. (US 3,801,072) in view of Gleeson et al (US Patent Application Publication 2001/0047741).

As to Claims 25, 26, 31, 68, 70, and 72. Newberry, Jr. discloses a fence picket comprising a plurality of layers of fiber cement (Col 2, Lines 59-64), wherein the picket (11) has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, and wherein the picket has a pattern formed on the front surface and back surface of the picket (Col 1, Lines 35-43), the pattern being applied to the front surface and to the back surface of the picket



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substantially simultaneously and the picket being made desired shape for use in the fence system prior to curing (Col 1, Lines 35-43),

the picket is secured to a the mounting surface (30) by a fastener passing through the front surface and the back surface of the individual member (Col 4, Lines 27-30) and into the mounting surface (30), and

the picket having at least one surface that has a pre-finish thereon resembling a wooden picket (Col 1, Lines 29-43); said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1; Col 3, Lines 61-64).

It is noted that the limitation of "the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed when the features are present. See MPEP § 2113.

Newberry Jr. does not disclose the pickets being made of fiber cement whereby the plurality of individual members do not exhibit any substantial fraying of the fibers along surfaces of the pickets after curing, wherein the fiber cement forming the pickets incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the pickets as taught by Newberry to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As to Claims 69 and 75. Newberry Jr. discloses the upper end of at least one individual member being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1—Shows the pickets with a dog-eared shape).

As to Claims 27, 32 and 76-78. Newberry Jr. discloses the front surface and back surface of at least one individual member having a first surface, wherein the first surface

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has a finish that is capable of resembling wood or the color thereof or masonry (Col 1, Lines 39-43).

As to Claims 29 and 30. Newberry Jr. discloses at least one exterior surface of the picket being stained or being textured (Col 1, Lines 39-43).

As to Claim 33. Newberry Jr. discloses the picket capable of being nailed onto a fence rail (Col 4, Lines 27-30).

As to Claims 71, and 73. Newberry Jr. discloses a fence system wherein each of said pickets has a length between about 6 and 8 feet (Col 2, Lines 5-7).

As to Claim 74. Newberry Jr. does not disclose a fence system wherein each of said pickets has a width between about 4 and 12 inches. However, it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have a width between about 4 and 12 inches so as to achieve the desired aesthetic appearance.

***Response to Arguments***

Applicants' arguments filed 12/14/2006 with respect to claims 1-7, 9-14, 15, 19, 34-37, and 39-45 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' arguments filed 12/14/2006 with respect to claims 25-27, 29-33, and 68-78 have been fully considered but they are not persuasive.

As to Claims 25 and 68, Applicants argue that:

*"While Newberry discloses that both sides of the panel can be replicated through use of multiple molds, there is no disclosure or suggestion in Newberry or Gleason of a fence panel having a pattern 'formed on the front surface and back surface of the picket, the pattern being applied to the front surface and back surface of the picket substantially simultaneously by two embossing rollers.'"*

*(Page 17)*

Examiner respectfully disagrees as to Claims 25 and 68, because, as advanced above, the limitation of "the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers" imparts limited patentable weight to the invention because this is a process recitation within a product claim and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only

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process has been recited. Accordingly, it is of little consequence how the surfaces features formed when the features are present. See MPEP § 2113.

As to Claim 72, Applicants argue that:

*"Gleeson does not disclose or suggest a fiber cement material for use in a fence system or as a fence picket as presently recited" (Page 18)*

Examiner respectfully disagrees as to Claim 72, because Gleeson et al disclose in Paragraph 107 that "the preferred embodiments have an applicability to a number of building product applications, including ... **fencing**..." (Emphasis added).

### **Conclusion**

Applicants' amendment, specifically the addition of the limitation of the mounting surface being "horizontal" (Claims 1, 15, and 34, Line 2), necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants' are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJK

JTK  
1/18/2007



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